

REMARKS

A. Election/Restriction

Claim 11 covers elected Species IV, but it is not limited to covering only Species IV. Applicant also notes that the Office's statement in its August 21, 2007 Election/Restrictions Action that "none of the claims" are generic (page 4) is not accurate. By the Office's own admission, claim 1 (which was not elected) is generic to species III, IV, V, and VI (see bottom of page 3). A claim need not read on every species disclosed in an application to be generic. *See* MPEP § 806.04(e) ("[A] claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a *generic or genus claim*).") (emphasis added).

B. Claim 11 Is Novel over Griswold.

Claim 11 stands rejected as anticipated by Griswold (US 6,508,377). Griswold discloses an *open*-bottom multiple-sectional garbage container, not a rodent bait station. The Office's contention that an open bottom (18) that is bordered by downwardly projecting latch members (27) meets the claimed bottom with one or more openings (this is a change from the previously-claimed "openings") is unsupported and contravened by how one of ordinary skill in this art would understand the claim language. Nevertheless, in an effort to expedite prosecution, and in order to distinguish Griswold's structure (and Jalbert's structure, as explained below), claim 1 has been amended to recite that the bottom is a *closed* bottom. Griswold fails to disclose or suggest such a bottom, and the rejection should be withdrawn.

Another independent reason that claim 11 is patentable over Griswold is that claim 11 now recites that the claimed plastic bait station includes *a sidewall with a doorway*. There is no doorway in "side wall 19" of Griswold's multiple-sectional garbage container, nor is there any logical reason to put a doorway in side wall 19 considering, for example, that garbage could spill

out of such a doorway, defeating the intended purpose of the container. MPEP 2143.01. For this additional reason, the rejection should be withdrawn.

C. Claims 11 and 12 Are Novel over Jalbert.

Claims 11 and 12 stand rejected as anticipated by Jalbert (US 3,708,905). Jalbert is a lobster trap, and it does not have a closed bottom with one or more openings, as claimed. Instead, it has a “bottom panel 4” made of spaced plastic strips 34 and 36. No one of ordinary skill in the art would read the claimed closed bottom on Jalbert’s bottom panel 4. The rejection is overcome and should be withdrawn.

D. Claim 12 Is Patentable over Griswold and Loebbert.

Claim 12 stands rejected as obvious over Griswold and Loebbert (US 5,150,810). Loebbert is directed to a waste disposal bag. Neither Griswold nor Loebbert discloses or suggests a sidewall with a doorway, as recited in claim 11. Accordingly, the rejection is overcome and should be withdrawn.

E. Claims 11 and 12 Are Patentable over Pruitt and Loebbert.

Claims 11 and 12 stand rejected as obvious over Pruitt (US 5,897,018) and Loebbert. Pruitt is directed to a garbage can locking system. Neither Pruitt nor Loebbert discloses or suggests a sidewall with a doorway, as recited in claim 11. Accordingly, the rejection is overcome and should be withdrawn.

Furthermore, the Office’s contention that it would be obvious to put one or more openings in the bottom of a garbage can is unsupported by the “rational underpinning” that *KSR* requires: garbage would leak out. See *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (“[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Accordingly, the rejection is overcome and should be withdrawn for this additional reason.

F. Claim 11 Is Patentable over Pruitt and Griswold.

Claim 11 stands rejected as obvious over Pruitt and Griswold. Neither Pruitt nor Griswold discloses or suggests a sidewall with a doorway, as recited in claim 11. Accordingly, the rejection is overcome and should be withdrawn.

G. Claim 12 Is Patentable over Pruitt and Griswold and Loebbert.

Claim 12 stands rejected as obvious over Pruitt and Griswold and Loebbert. Loebbert fails to cure the deficiency of Pruitt and Griswold. Accordingly, the rejection is overcome and should be withdrawn.

H. Claims 11 and 12 Are Patentable over Crossen and Pruitt or Morell.

Claims 11 and 12 stand rejected as obvious over Crossen (US 6,513,283) and Pruitt or Morell (US 3,343,744). The Office admits that Crossen fails to disclose a receptacle having protrusions, and that Crossen fails to disclose a plurality of openings in the bottom of the plastic bait station. However, the Office contends that it would have been obvious to modify Crossen's "receptacle" (which the Office contends is the outer portion (without the denser, heavier middle section) of weight 120) and its plastic bait station to meet these claim limitations because "it has been held that the mere duplication of the essential working parts involves only routine skill in the art, and because the utilization of a plurality of openings and protrusions would allow the connection between the bait station and receptacle to be stronger and more evenly held together at a plurality of locations." Action at 7. The Office also admits that Crossen does not disclose placing pre-formed weighted material in the receptacle. But it contends that "[i]t would have been obvious . . . to modify the method of Crossen such that pre-formed weighted material is placed in the receptacle in view of Pruitt . . . in order to provide the user with the ability to fill the receptacle at the time of use with the desired type of material having the density property necessary to weight the base station and keep it in place." Action at 8.

Respectfully, the Office's rejection is not understood. It contains an internal inconsistency, and lacks the requisite clarity about which "receptacle" the Office contends should be used with Crossen's bait station. In any event, as explained below, the Office fails to establish a *prima facie* case of obviousness with respect to the proposed Crossen + Pruitt combination and with the proposed Crossen + Morell combination. The rejection should be withdrawn.

The internal inconsistency: In the part of its rejection on page 7 of the Action the Office contends that Crossen discloses "placing pre-formed weighted material in the receptacle (123; 123 is preformed in that it is formulated to be harder/more dense than periphery of 120; no particular method step being recited) in the receptacle (120) (sic)" Then, on page 8 of the Action, the Office concedes that Crossen "*does not* disclose placing pre-formed weighted material in the receptacle." (Emphasis added). The Board is unforgiving of internal inconsistencies, *see Ex parte O'Brien*, Appeal No. 2002-1846, slip op. at 4-6 (BPAI Sept. 20, 2002) (non-binding), and should be given the burden on the Office to issue clear rejections. MPEP § 707.07(d) ("Where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated"); *Ex parte Ronsen*, Appeal No. 2001-1933, slip op. at 10 (BPAI 2003) (non-binding) (addressing Appellant's assertion of the Office's failure to comply with MPEP 707.07(d) and stating, "[w]e remind the examiner, in the interest of due process to appellants, that the grounds for rejection of each claim should be delineated with a requisite and reasonable degree of specificity.").

1. The asserted combination of Crossen and Pruitt fails.

The Office fails to explain what it means by "the receptacle" at the bottom of page 8 of the Action. *If the Office is contending that the "receptacle" is the one in Crossen – i.e., the*

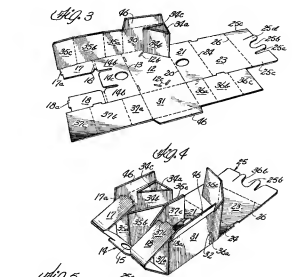
outer ring of weight 120 without the denser, heavier section 123 – its rejection fails for several reasons. First, and most simply, *a ring is not a receptacle* because it has no bottom to support anything placed in it (were it even possible to place something “in” a ring). Second, eliminating the heavier, denser section 123 of weight 120 is not obvious because it would change the principle of operation of Crossen’s invention, which he contends is the overall weight itself (especially the central section 123 the Office advocates eliminating), and render Crossen’s invention unsuited for its intended use. See MPEP 2143.01 V. “THE PROPOSED MODIFICATION CANNOT RENDER **THE PRIOR ART** UNSUITABLE FOR ITS INTENDED PURPOSE” and VI. “THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF **A REFERENCE.**” Crossen explains that the denser, heavier section 123 of his weight is important because it is the portion of the weight that is directly coupled to the bait station and because it vastly improves the anchoring characteristics of his weight. See col. 2, lines 5-8 (The portion of the weight that is directly coupled to the bait station is denser than the remaining portion of the weight. *This increased hardness at the point of attachment ensures a strong connection.*) (emphasis added); col. 3, lines 46-55 (“The solid section **123** centralizes the weight distribution of the weight **120** which *vastly improves* the anchoring characteristics of the weight **120.**”) (emphasis added). Eliminating section 123, therefore, *would not have been obvious*. See *Ex parte Farbrot*, Appeal No. 2008-4799, slip op. at 12-14 (BPAI Feb. 24, 2009) (non-binding) (reversing an obviousness rejection premised on the replacement of the primary reference’s lotion with the gel of a secondary reference because doing so “would eliminate a critical function” of the primary reference’s product). For each of these reasons, the rejection based on Crossen and Pruitt is overcome and should be withdrawn if the Office is relying on the outer ring of weight 120 of Crossen as the receptacle.

If the Office is contending that the “receptacle” is Pruitt’s base 12, its rejection also fails for several reasons. First, adopting Pruitt’s base—which includes upwardly-projecting tabs 20 that clip to the *outside* of annular ring 34 located on the side wall of Pruitt’s garbage can—would eliminate the need for any openings in the bottom of Crossen’s bait station, *and thus would not satisfy all the limitations of claim 11*. Were the Office to take the position that both Crossen’s bait station and Pruitt’s base should be re-designed to somehow meet claim 11, those structures would look nothing like what is shown in the references themselves, making the proposed combination all the more indefensible. Furthermore, it is not obvious to eliminate a weight that Crossen describes as his invention (col. 1, line 66 – col. 2, line 2 (“The invention is a tough, durable rodent bait station weight”)) in favor of a fillable base from a *garbage can patent* to address a non-existent problem: “weight[ing] the bait station and keep[ing] it in place.” Action at 8. *As the Board has held, a problem that a primary reference has already solved is not one that can support a finding of obviousness. See Ex parte Rinkevich*, Appeal No. 2007-1317, slip op. at 8-9 (BPAI May 29, 2007) (noting that “the problem proffered by the Examiner is already solved” by the primary reference, and explaining that “a person of ordinary skill in the art having common sense at the time of the invention would not have reasonably looked at [a secondary reference] to solve a problem already solved by [the primary reference].”). For these reasons, the rejection based on Crossen and Pruitt is overcome and should be withdrawn if the Office is relying on Pruitt’s base 12 as the receptacle.

2. The asserted combination of Crossen and Morell fails.

This rejection fails to teach or suggest all the limitations of claim 11. For this rejection, Crossen’s “receptacle” must remain (i.e., the outer ring of 120 without heavier, denser section

123) because Morell fails to disclose or suggest a bait station that is separate from but securable to a receptacle. Instead, Morell discloses a foldable box:



As these figures show, Morell's compartments are inside the bait station, not secured to them with protrusions that extend up through the bottom of the bait station. In fact, the claimed configuration is the antithesis of Morell's foldable construction. This is clear from reviewing the first column of Morell's patent.

However, there is no rational reason to modify Crossen's weight 120 in view of Morell. See *In re Khan*, 441 F.3d at 988 (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoted with approval in *KSR*, 550 U.S. at 418). And even were center section 123 to somehow be removed from weight 120, the resulting outer ring would not be a “receptacle,” as explained above. Furthermore, all the problems with modifying weight 120 would remain: it would change the principle of operation of Crossen and render it unsuited for its intended purpose, considering Crossen's view that the weight 120—including the important heavy central section 123—is his invention (col. 1,

line 66 – col. 2, line 2), and considering the importance Crossen places on the heavy central section as an anchor and attachment point. Col. 2, lines 5-8 and col. 3, lines 46-55.

For these reasons, the rejection based on Crossen plus Morell fails and should be withdrawn.

I. Claims 11 and 12 Are Patentable over Crossen and Faucillon.

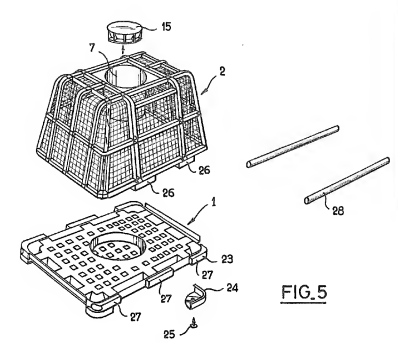
Claims 11 and 12 stand rejected as obvious over Crossen and Faucillon (US 4,486,973). The Office admits that Crossen does not disclose a plastic bait station having a bottom with openings, a receptacle having protrusions, or placing pre-formed weighted material in the receptacle. However, the Office contends that Faucillon discloses a bait station “having a lid (15), a base (2) having a bottom with openings (26), and a receptacle (1) with protrusions (28, 28, 27) configured to extend through the openings in the bottom of the base, and wherein a pre-formed weighted material (concrete blocks 19) is placed in the receptacle.” The Office then contends:

weighted material (concrete blocks 19) is placed in the receptacle. It would have been obvious to a person of ordinary skill in the art to modify the method of Crossen such that the base and receptacle have openings and protrusions and that a pre-formed weighted material is placed in the receptacle in view of Faucillon in order to provide a plurality of attachment points for the bait station and receptacle to more evenly hold the separate bait station and receptacle together and also to allow the user to add as much weight as necessary before deployment of the bait station.

Applicant traverses. The Office’s rejections fails for several reasons.

First, Faucillon does not disclose a bait station with a closed bottom, as Crossen does. Instead, Faucillon discloses an open-bottomed cage. Sleeve-shaped parts 26 are integral with the bottom edge of the open cage, and they line up with complimentary parts 27 that project from

bottom 1 of Faucillon. Pins are then passed through the aligned sleeves (26 and 27) to secure the bottom 1 to the cage 2:



There is nothing about Faucillon that would lead one of ordinary skill in the art to modify Crossen's plastic bait station to have sleeves 26, or to modify weight 120 to have complimentary sleeves 27, so that a pin 28 could be slid through them. That would be an untenable modification of Crossen, given his emphasis on using the central, heavy, harder section 123 of which weight 120 as the attachment point between the bait station and his weight.

Furthermore, if the Office is advocating eliminating section 123 in order to make room for what the Office characterizes as concrete blocks 19, the rejection is untenable for several of the reasons given above and more: As explained above, eliminating section 123 would leave Crossen with only an outer ring of weight 120, which cannot be a receptacle; and eliminating section 123 would change the principle of operation of Crossen and render it unsuited for its intended purpose given the emphasis Crossen places on section 123 (as explained fully above). Furthermore, Faucillon *does not* disclose placing concrete blocks 19 in bottom 1, as the Office

incorrectly contends. As explained in detail in the last response, the bottom 1 of Faucillon's trap includes a peripheral channel for holding concrete "or other like ballast may be poured" (col. 1, lines 35-39); the wet concrete is poured into openings 12 and apparently flows through passages in the bridge separators 13 to provide a continuous ring of weighted material. Col. 2, lines 37-41. Wet concrete is not pre-formed weighted material (it is unformed). Regardless, however, no rational person would pour wet concrete into the bottomless outer ring of weight 120 that would exist if central section 123 were removed.

For these reasons, the rejection is overcome and should be withdrawn.

J. Conclusion

Claims 11 and 12 are in condition for allowance. The Examiner is invited to contact Applicant's attorney with any questions or comments relating to this application.

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